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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,567

03/29/2007

Chikara Ohki

2006\_0503A

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7590

07/08/2009

WENDEROTH, LIND & PONACK, L.L.P.

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EXAMINER

VELASQUEZ, VANESSA T

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

07/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/574,567	<b>Applicant(s)</b> OHKI ET AL.	
	<b>Examiner</b> Vanessa Velasquez	<b>Art Unit</b> 1793	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 22 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☒ Applicant's reply has overcome the following rejection(s): 112-2<sup>nd</sup> paragraph as applied to claims 1-4.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1,2 and 4.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/George Wyszomierski/  
 Primary Examiner  
 Art Unit 1793

/Vanessa Velasquez/  
 Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because:

- (1) The previous objection to the specification for containing new matter is withdrawn in view of Applicant's remarks.
- (2) The previous objection to claim 1 is withdrawn in view of the amendment to the claim.
- (3) The previous rejection of claims 1-4 under the second paragraph of 35 USC 112 is withdrawn in view of amendments to the claims.

Applicant's remarks have been considered, but do not place the application in condition for allowance because the claims stand rejected for the same reasons set forth in the final Office action dated March 24, 2009. Note that the limitations of claim 3 were incorporated into claim 1, and that the amendments to claim 1 were made to obviate the prior rejection under the second paragraph of 35 USC 112. However, the prior art of record and the remarks made by the Examiner still appropriately apply to the amended claims. Response to arguments is as follows:

(a) Applicant argues that there is no evidence showing that the carbonitriding process of the prior art produces the nitrogen enriched layer of the claimed invention. Applicant further argues the conclusion at which the Examiner arrived was merely conclusory and it did not explain how that conclusion was reached. The Examiner respectfully disagrees. It was made clear in the Office action that the carbonitriding processes disclosed by Applicant appear to be substantially identical to that of the present invention. Furthermore, these substantially identical processes were applied on alloys that are substantially identical in terms of chemical composition. One of ordinary skill in the art would recognize that applying identical processes to identical substances would produce substances with identical features and properties. Therefore, the composition of the nitrogen-enriched layer, including the depth at which it is measured, would be expected by the skilled artisan to be substantially identical to that of the claimed invention.

(b) Applicant argues that there is no teaching in Ohki that titanium would be present in the claimed amount. In response, Applicant has ignored the teachings of secondary reference Okita et al. (US 5,672,014), which was also relied upon in the rejection of claim 1. Although Ohki is silent to titanium content, it is well known in the steel arts that impurities in steel bearings include elements such as sulfur, oxygen, and titanium (Okita, col. 10, lines 52-63). Furthermore, the complete or substantially complete removal of said impurities is not economically practical given the large costs involved with the removal process (Okita, col. 10, lines 59-64). Okita et al. further teach that hardness and retained austenite are of much greater concern than suppressing impurities (col. 11, lines 1-5). Thus, because the efforts were not made to completely or substantially completely remove impurities from the steel, one would expect that impurities such as titanium, sulfur, and oxygen remain therein.